

REMARKS

OVERVIEW

Applicants have reviewed and considered the Office Action dated November 3, 2006. Claim 1 has been amended so that it now recites "transforming a fungus cell with *Agrobacterium* under suitable conditions whereby recombination occurs". Support for this amendment may be found throughout the specification, for example, at claim 3 as originally filed. Claim 3 has been canceled. New claim 66 has been added. Support for this additional claim may be found throughout the specification, for example, at pages 21-22 and 44 as originally filed. No new matter has been added. Upon entry of the foregoing amendments, claims 1-2 and 4-66 are pending in the instant application. Applicants respectfully request reconsideration of the above-identified application in view of the amendments above and remarks that follow.

CLAIM REJECTIONS UNDER 35 U.S.C. § 102

Claims 1, 2, 5, 6, 7, 8, 9, 10, 11 and 15 stand rejected under 35 U.S.C. § 102(b) as being allegedly anticipated by Capecchi et al. (U.S. Patent No. 5,464,764).

Applicants respectfully traverse this rejection. Applicants submit that the claimed invention is not anticipated by the cited reference as it fails to teach all of the elements of Applicants' claimed invention.

Applicants respectfully traverse this rejection as applied to amended claim 1. As amended, claim 1, in part, recites "transforming a fungus cell with *Agrobacterium* under suitable conditions whereby recombination occurs". Support for this amendment can be found throughout the Specification and in claim 3 as originally filed.

The Examiner admits at page 4 of the Office Action that Capecchi et al. does not describe using *Agrobacterium* to transform fungus. Rather the Capecchi et al. describes that *Agrobacterium* can be used to transform plant cells. Col. 18, lines 41-61. Thus, claim 1 is not anticipated by Capecchi et al. because Capecchi et al. does not teach “transforming a fungus cell with *Agrobacterium* under suitable conditions whereby recombination occurs”. Thus, Capecchi et al. does not teach each and every element of claim 1. Claims 2, 5, 6, 7, 8, 9, 10, 11 and 15 depending from claim 1 are likewise not anticipated for the reasons argued above, plus the elements in the claims. Applicants respectfully request that this rejection be withdrawn and reconsidered.

CLAIM REJECTIONS UNDER 35 U.S.C. § 103

Claims 1-15 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Capecchi et al. in view of de Groot et al. (Nature Biotechnology Vol. 16, pp. 839-842, 1998), Grosjean-Crouneyer et al. (U.S. Patent 6,617,163).

The Examiner states it would have been obvious to one of ordinary skill in the art to have used the positive/negative transformation method disclosed by Capecchi et al. and the *Agrobacterium* transformation method applied to fungi, including such well known strains as *Aspergillus fumigatus*, *Botrytis cineria*, *Magnaporthe grisea* and *Fusarium oxysporum* since de Groot et al. discloses that all filamentous fungi may be transformed using the *Agrobacterium tumefaciens* bacteria technique and since the art including Grosjean-Courneyer et al. disclose that numerous filamentous fungi may be transformed with recombinant DNA techniques, and all of the above references are concerned with the transformation of fungi of interest using recombinant methods. The Examiner states that one would have been motivated to do so by the desire to

obtain the disclosed advantages of the positive/negative transformation technique of Capecchi et al., which include the ability to select against illegitimate (non-homologous) insertion of recombinant DNA into the genome of fungi of interest, and to obtain the well known advantages of the technique of *Agrobacterium tumefaciens* transformation which are disclosed in de Groot as being applicable to all fungi.

Applicant respectfully traverse this rejection as the Office Action failed to make a *prima facie* case of obviousness for the following reasons: the fact that references can be combined or modified is not sufficient; and there is no suggestion to combine the cited references because a suggestion to combine must come from the prior art and not from Applicant's specification or impermissible hindsight.

Applicants respectfully remind Examiner that the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicant's disclosure. *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); MPEP § 2143. Motivation to combine references requires that the combination sought to be made be desirable, not merely feasible. *Winner International Royalty Corp. v. Wang*, 53 USPQ2d 1580, 1587 (Fed. Cir. 2000). However, there is no suggestion in the art that it is desirable to use the methods of de Groot to complement, replace or supplement the methods in Grosjean-Courneyer et al. and Capecchi et al. The fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990); MPEP § 2143.01. Accordingly, there is no teaching, suggestion or motivation to combine the cited references.

Applicants respectfully remind the Examiner that she must avoid hindsight. *In re Bond*, 910 F.2d 831, 834, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990). It respectfully submitted that the Examiner appears to be employing hindsight to arrive at the Applicants' invention, selecting aspects from at least three different references to attempt to piece together Applicants' invention.

The Examiner is reminded that it is impermissible to use the Applicants' specification as a template to arrive at the conclusion that the claimed invention is obvious. Moreover, the present invention must be considered as a whole. In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); *Schenck v. Nortron Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983); *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1985); MPEP § 2141.02.

Therefore, claim 1 is nonobvious. Claims 2 and 4-15 dependent on nonobvious claim 1 are likewise nonobvious over Capecchi et al., de Groot et al., and Grosjean-Courneyer for similar reasons as those argued above. In view of the traversal made above, Applicants respectfully request reconsideration and withdrawal of the rejection to claims 1-2 and 4-15 under 35 U.S.C. §103(a).

ADDITIONAL CLAIM

New claim 66 has been added. Support for this claim may be found throughout the specification, for example, at pages 21-22 and 44 as originally filed. No new matter has been added.

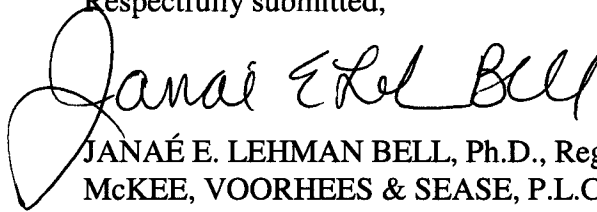
CONCLUSION

Please consider this a Request for a One-Month Extension of Time from February 3, 2007 to March 3, 2007 and charge Deposit Account No. 26-0084 the amount of \$60.00 for this extension.

Please also charge Deposit Account No. 26-0084 the amount of \$100.00 for one new independent claim. No other fees or extensions of time are believed to be due in connection with this amendment; however, consider this a request for any extension inadvertently omitted, and charge any additional fees to Deposit Account No. 26-0084.

Reconsideration and allowance is respectfully requested.

Respectfully submitted,

A handwritten signature in black ink, reading "Janae E. Lehman Bell". The signature is fluid and cursive, with the first name "Janae" being the most prominent.

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